

REMARKS

In response to the Office Action dated July 14, 2004, Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance. A Request for Continued Examination (RCE) is being filed concurrently with the present response.

Claims 1-22 were rejected in the office action. Claims 1, 8 and 18 have been amended. No claims have been canceled. Therefore, following entry of the present response, claims 1-22 will remain pending in the present application

Claims 1-6, 18-20 and 22 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 6,343,123 to Lehmacher *et al.* ("Lehmacher"). More specifically, the office action contends that Lehmacher teaches, *inter alia*, providing a toll-free telephone number to a foreign market provider that is trying to validate a request from an out of market customer, at column 5, line 40 through column 6, line 50. (*Office Action dated July 14, 2004* at p. 2-3). Applicants respectfully disagree.

Briefly, one embodiment of the present invention includes a creative and novel solution to a problem created by "roaming" mobile telephones. When mobile telephones "roam" outside of their "home" market they are at the mercy of a "foreign" market provider to complete a call. As a result, additional costs may be added to the call by the foreign market provider. Typically, when a roaming mobile customer enters a toll-based telephone number (*i.e.*, a call that requires a toll charge) and hits the "send" button, a foreign mobile switching center (MSC) verifies the call with the customer's home MSC. In particular, the foreign MSC receives a signal and then sends a message to the customer's home MSC to validate the caller and to make sure that the foreign provider will be compensated for

handling the “roaming” call. The validating message also includes the telephone number that the customer wishes to call.

The embodiment of the present invention provides a novel technique for avoiding such additional costs by the foreign market provider. When the foreign MSC sends a validation request to the home MSC, instead of simply validating the number, the home MSC is set up to return a toll-free number (*e.g.*, an “800” telephone number) to the foreign MSC. As a result, instead of completing the call, the foreign market provider routes the “800” telephone number back to the home market’s network, as it does with all toll-free numbers. The home market receives the “800” number and is set up to recognize that the number is really an attempt by its out-of-market customer to dial the toll-based number. Therefore, the home market converts the “800” number to the toll-based number, and completes its customer’s call. Notably, the call is completed by the home market and the only participation by the foreign market is not to complete the call, but to forward a cost free call to the home market’s network.

Claims 1, 8 and 18 have been amended to more clearly recite the novel features of the embodiment of the present invention. In particular, claim 1 recites a method that includes receiving a customer validation request from a foreign market provider. The customer validation request may be sent by the foreign market provider to the home market provider when the out of market customer attempts to dial a toll-based number. In response to the customer validation request, the home market provides the foreign market with a predetermined toll-free telephone, instead of or in addition to providing the customer validation information. The home market provider, for example, will receive a call request from the foreign market provider that is based on the predetermined toll-free telephone

number. The home market provider may then convert the predetermined toll-free toll-based telephone number that the customer originally dialed, for example. As a result, the customer's out of market call is directed out of the foreign market using a toll-free connection that prevents the foreign market provider from appending its own charges.

Lehmacher, on the other hand, does not disclose the method described above. In fact, Lehmacher does not even provide any method that allows an out-of-market customer to avoid costs placed by the foreign market provider. A thorough reading of its specification reveals that Lehmacher is directed to enabling "the use of toll-free universal call numbers, which do not need to be centrally and managed all over the world." (*Lehmacher* – column 2, lines 2-4). In other words, Lehmacher attempts to provide one universal telephone number that "is valid in several national communications network telephone networks and can thus be used for example in the U.S. and in Germany as well." (*Lehmacher* – column 1, lines 35-28). With all due respect, the Examiner is respectfully requested to recognize that there is no suggestion in Lehmacher for allowing an out of market customer to dial a toll-based number without incurring costs by a foreign network provider.

The office action cites column 5, line 40 through column 6, line 50 for the notion that Lehmacher provides a toll-free telephone number to a foreign market provider that is trying to validate a request from an out of market customer. However, a close reading of each relevant portion of this cited section reveals that Lehmacher does not provide such teaching. Instead, column 5, lines 40-55 simply describe a technique for allowing an out of market customer to register with a foreign market provider. This out of market registration technique is well known to those skilled in the present art. However, the embodiment of the present

invention goes much further than Lehmacher in describing a method of using this technique to allow an out of market customer to avoid charges by the foreign market provider.

Continuing with the portion cited in the office action, column 5, line 56 to column 6, line 8, describe how “toll-free universal call numbers” are stored and manipulated as part of this well known out of market registration technique. However, again, this description has nothing to do with the method described in the embodiment of the present invention for allowing an out of market customer to avoid charges by the foreign market provider.

Finally, column 6, lines 9-50 describe a “sequence for establishing a connection from subscriber A to a subscriber with a toll-free universal call number.” (*Lehmacher* – column lines 9-11). In other words, Lehmacher describes a method for allowing a subscriber to connect to a toll-free universal number anywhere in the world. With all due respect, this has little to do with the embodiment of the present invention. The embodiment of the present invention allows an out of market subscriber (not just any “subscriber”) to connect to a toll-based number (not a toll-free universal call number) without having to incur costs of the foreign market provider. This simply is not even close to the Lehmacher or the cited sections therein.

Accordingly, withdrawal of the rejection of claims 1-6, 18-20 and 22 under 35 U.S.C. § 102 (b) over Lehmacher is believed proper and respectfully solicited.

Also, claims 7 and 17 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Lehmacher in view of WO 00/27144 to Valsa *et al.* (“Valsa”). Applicants respectfully assert that claims 7 and 17 are distinguished over the teachings of Lehmacher in view of Valsa for the same reasons discussed above with respect to the rejection of claims 1-6, 18-20 and 22 under 35 U.S.C. § 102 (e) over Lehmacher. Accordingly, withdrawal of the rejection

of claims 7 and 17 under 35 U.S.C. § 103 (a) as being obvious over Lehmacher in view of Valsa is believed proper and respectfully solicited.

In addition, claims 8, 9 and 12-16 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Lehmacher in view of in view of U.S. Patent No. 6,345,182 to Fabritus *et al.* ("Fabritus"). Applicants respectfully assert that claims 8, 9 and 12-16 are distinguished over the teachings of Lehmacher in view of Fabritus for the same reasons discussed above with respect to the rejection of claims 1-6, 18-20 and 22 under 35 U.S.C. § 102 (e) over Lehmacher. Accordingly, withdrawal of the rejection of claims 8, 9 and 12-16 under 35 U.S.C. § 103 (a) as being obvious over Lehmacher in view of Fabritus is believed proper and respectfully solicited.

Claims 10 and 11 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Lehmacher in view of Fabritus and in further view of U.S. Patent Application No. 2003/0185373 to Boughman *et al.* ("Boughman"). Applicants respectfully assert that claims 10 and 11 are distinguished over the teachings of Lehmacher in view of Fabritus and Boughman for the same reasons discussed above with respect to the rejection of claims 1-6, 18-20 and 22 under 35 U.S.C. § 102 (e) over Lehmacher. Accordingly, withdrawal of the rejection of claims 10 and 11 under 35 U.S.C. § 103 (a) as being obvious over Lehmacher in view of Fabritus and Boughman is believed proper and respectfully solicited.

Finally, claim 21 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Lehmacher in view of U.S. Patent Application No. 2004/0005874 to Malackowski *et al.* ("Malackowski"). Applicants respectfully assert that claim 21 is distinguished over the teachings of Lehmacher in view of Malackowski for the same reasons discussed above with respect to the rejection of claims 1-6, 18-20 and 22 under 35 U.S.C. § 102 (e) over

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Lehmacher. Accordingly, withdrawal of the rejection of claim 21 under 35 U.S.C. §103 (a) as being obvious over Lehmacher in view of Malackowski is believed proper and respectfully solicited.

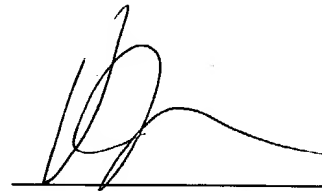
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CONCLUSION

In view of the foregoing, Applicant respectfully submits that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow the present application for any reason, the Examiner is encouraged to contact the undersigned attorney, Vincent J. Roccia at (215) 564-8946, to discuss resolution of any remaining issues.

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